

### REMARKS

Reconsideration and allowance of this application are respectfully requested.

As required in the Office Action, a new Reissue Declaration is submitted herewith.

New claims 35-37 recite further patentable aspects of this invention.

The Office Action rejects the pending claims based on the recapture rule. This rejection is respectfully traversed. It is submitted that this rejection is unwarranted on the facts of the present case, for the following reasons.

#### A. PROSECUTION HISTORY OF PARENT APPLICATION

In the Office Action of August 17, 1992, claims 1 and 6 were rejected under 35 USC 102(e) as anticipated by Nishiuchi et al.

The Office Action stated that Nishiuchi et al. show "an optical recording and reproducing apparatus comprising N converging means (elements 8 and 9 of Fig. 1 and Figs. 2(a)-2(d)), disc discriminating means 10, and control means 11 & 16. With respect to the limitation of claim 6 see Fig. 1 elements 3 regarding the light source, objective lens 8, photodetectors 14 & 15, selecting one of the aberration correcting means Figs. 2(a)-2(d), disc discriminating means 10 and control means 11 and 16."

While indicating that claims 2-5 and 7-30 were directed to allowable subject matter, the Office Action stated that "None of the cited prior art shows or teaches an optical head apparatus comprising a plurality of heads (objective lenses) or converging grating couplers, a light beam, photodetectors, moving means, selective means, a disc discriminating means and a control means for generating a control signal to the selecting means to select a grating coupler or an optical head (objective lens) in which the occurrence of aberration of the disc is smallest in accordance with the disc discrimination signal." There was no statement of reasons for allowance in the Notice of Allowability.

In response to the first Office Action, claims 1, 6, 11, 16, 21 and 26 were canceled, and claims 2-5 and 7-10, 12-15, 17-20, 22-25 and 27-30 (deemed in the Office Action as allowable) were rewritten in independent form where appropriate, so as to be placed in condition for allowance. Claims 2, 4, 5 and 7-9 were also amended to overcome a 35 USC 112, second paragraph, rejection.

**B. PENDING CLAIMS IN PRESENT REISSUE APPLICATION**

Claims 26 and 28-34 (as discussed in detail below) recite several elements and features not recited in original canceled claim 1 or 6 and omit certain elements of the issued claims which were included in original claims that were, in a first office

action, indicated as allowable and which were, in response, not amended to alter their scope but merely rewritten in allowable form.

Thus, the present reissue claims "differ materially" from canceled original claims 1 and 6. The material differences include:

Claim 26

The optical recording/reproducing apparatus is defined as recording, reproducing or erasing an information signal onto/from any one of N types (where  $N \geq 2$ ) of optical discs having first layers of different thicknesses, each type of the optical discs having at least the first layer being transparent and a second layer for storing information, by converging a light flux onto the second layer through the first layer of one of the N types of optical discs loaded in the apparatus. This preamble is different from that of original claims 1 and 6. Claim 87 recites a composite converging optical device including (i) a light emitting means for emitting a light flux (this element is not present in original claim 1 or 6) and (ii) a converging means for converging the light flux on the second layer of the one of the N types of optical discs loaded in the apparatus, and (iii) an optical wave front correcting means disposed in an optical path connecting the light emitting means and the converging means for

correcting an optical wave front of the light flux; the composite converging optical device (a) performs aberration correction in correspondence with the first layer of the one of the optical discs loaded in the apparatus and (b) converges the light flux as a smaller spot diameter  $D$  with respect to one of the optical discs having a thinner one of the substrates onto the second layer of the loaded optical disc; the composite converging optical device differently corrects the optical wave front of the light flux in correspondence with the different thickness of the  $N$  optical discs to provide the aberration correction and the converging of the light flux (a composite converging optical device and the function defining this converging device is significantly different from the converging means of original claim 1 or 6). Claim 26 recites that a thickness of the first layers of each of the  $N$  types of optical discs is about 1.2mm or less. This subject matter is not present in original claim 1 or 6.

Claims 29 and 30 dependent from claim 26

These claims recite that the composite converging optical device has different numerical apertures and converges the light flux as a spot with a smaller diameter  $D$  by employing a larger one of the numerical apertures and that each of the first layers

comprises a transparent substrate. This subject matter is not present in original claim 1 or 6.

Claim 28

Claim 28 recites an optical recording/reproducing system comprising an optical recording/reproducing apparatus as in claim 26. It further recites a signal processing means, responsive to one of (i) a reproduction signal, corresponding to the information signal, from the photo detecting means and (ii) receipt of recording data, corresponding to the information signal, for recording on the disk, for generating an output signal corresponding to the information signal for performing one of a reproducing operation and a recording operation on the discs; and a system controlling means coupled to the signal processing means for controlling generation of the output signal of the signal processing means. Neither of these elements is present in original claim 1 or 6.

Claims 31 and 32 dependent from claim 28

These claims recite that the composite converging optical device has different numerical apertures and converges the light flux as a spot with a smaller diameter  $D$  by employing a larger one of the numerical apertures and that each of the first layers comprises a transparent substrate. This subject matter is not present in original claim 1 or 6.

Claim 34

Claim 34 recites a system comprising an optical recording/reproducing apparatus as in claim 26. It further recites a signal processing apparatus including signal processing means, responsive to one of (i) a reproduction signal, corresponding to the information signal, from the photo detecting means and (ii) receipt of recording data, corresponding to the information signal, for recording on the disk, for generating an output signal corresponding to the information signal for performing one of a reproducing operation and a recording operation; and system controlling means coupled to the signal processing means for controlling generation of the output signal of the signal processing means. This subject matter is not present in original claim 1 or 6.

C. EXAMINER'S POSITION IN OFFICE ACTION

The Office Action states that "Applicant amended original claims 1, 7 and 10 to include the limitation "an objective lens for converging the light flux onto a disk," "N optical heads," "N optical heads moving means," and "disk discriminating means." Such limitations are now removed from the present application. Similarly, claims 13, 16 and 19 were also amended to include the limitation "plural converging grating couplers" which is now removed."

The Office Action incorrectly states that each of claims 7 and 10 recites N optical heads; instead, they recite an optical head.

The Applicants note that the statement in the Office Action that original claims 1, 7 and 10 were amended to include the noted elements is also incorrect. First, claim 1 (and claim 6) were canceled, not amended. Second, the original claims indicated as allowable in the first Office Action and rewritten in independent form originally included the elements of claim 1 and/or 6 by virtue of the fact that a dependent claim incorporates all of the features of a claim or claims from which it depends. The prosecution of the original application involved, in brief, canceling the rejected claims and rewriting claims deemed allowable by the examiner in independent form. The allowable claims rewritten in independent form are no narrower after such rewriting than before, and should be treated no differently than if they were in independent form from the beginning of prosecution. The present application is no different from a broadening reissue application of any claim whose scope was never amended. Thus, the prosecution activity in the parent application should be deemed at most a surrender of the combination of subject matter of original claims 1 and 6, but

not an admission that only claims as narrow as the claims rewritten in independent form are allowable.

D. PRINCIPLES UNDERLYING THE RECAPTURE RULE

MPEP 1202 states the general recapture rule as follows: "A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent."

In *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984), the Court of Appeals for the Federal Circuit (CAFC) found that certain reissue claims at issue were not barred by the recapture rule despite their being narrower in at least one aspect and broader in at least one aspect than claims canceled during prosecution. The court stated the rule that reissue claims that are of different scope from canceled claims avoid the effect of the recapture rule.

The MPEP, citing *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), sets forth a two step test for applying the recapture rule. The first step is to determine whether and to what aspect the reissue claims are broader than the patent claims. The next step is to determine whether the broader aspects relate to surrendered subject matter by looking to the prosecution history for arguments or claim amendments made in an effort to overcome a prior art rejection.



The MPEP at page 1400-9 states:

"If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists." (emphasis added).

At page 1400-10 through 1400-11, the MPEP states:

"Reissue claims that are broader in certain aspects and narrower in others vis-à-vis claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). "[I]f the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; [] if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible." *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165."

"If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture." (emphasis added).

The decision in *Hester Industries Inc. v. Stein Inc.*, 46

USPQ2d 1641 (Fed. Cir. 1998) helps to explain the rules set forth in the above-cited portions of the MPEP. The Hester court stated

that (1) reissue claims are not barred under the recapture rule if they are directed to subject matter whose patentability is not counter to the applicant's arguments during prosecution of the parent case (see page 1649) and (2) the recapture rule is avoided where the reissue claims are materially narrowed in some respects, despite being broadened in other respects (see page 1649).

These principles were applied by the CCPA in *In re Wadlinger et al.*, 181 USPQ 826 (CCPA 1974). There, the court said that the test for improper recapture is whether the reissue claims attempt to recapture the same or an "immaterially" different claim from that canceled during prosecution. Where the reissue claims are materially different from the canceled claims, the recapture rule is inapplicable. See also Chisum on Patents, Chapter 15.03[2](e), which states that a patentee may obtain on reissue a claim that "varies materially" from the claim originally surrendered, even if it omits a limitation intentionally added to obtain issuance of the patent.

*B.E. Meyers & Co. v. United States*, 56 USPQ2d 1110 (U.S. Ct. of Fed. Cls. 2000) is also instructive in applying the recapture rule. In *B.E. Meyers & Co.*, the U.S. Court of Federal Claims stated that determining whether a reissue claim is broader than a canceled claim involves more than simply counting the number of

claim elements or claim limitations. In the facts of that case, the applicants surrendered subject matter requiring a "generic" pulsing diode, by adding narrowing limitations to the pulsing diode. In the reissue claims, the limitations relating to the pulsing diode were deleted altogether. The court stated at page 1116:

"In essence, plaintiff conceded that more generic forms of pulsing circuitry had already been patented by other inventors....Contrary to defendant's argument, plaintiff's deletion of the pulsing diode and substituting pulsing current limitations did not effect an improper recapture of surrendered subject matter." (emphasis added).

The *B.E. Meyers* decision thus supports the principle that reissue claims may omit amended elements of the claims of the parent patent, although the reissue claims may not be permitted to reinsert the amended element in its original generic form which was surrendered.

#### E. INAPPLICABILITY OF RECAPTURE BAR TO PRESENT CASE

The present reissue claims are not barred under the recapture rule because they recite subject matter of a scope that differs significantly from that of the canceled claims of the original application.. Claims 26 and 28-34 materially differ from canceled original claims 1 and 6 at least with respect to the significant differences in claim elements and the newly added

narrowing limitations identified in Section C above, resulting in claims with a materially different scope from canceled original claims 1 and 6.

Further, there is nothing in the prosecution history that establishes an admission that the subject matter of the presently pending claims was surrendered. The limitations of the patent claims omitted in the present reissue claims were indicated as allowable in the first office action of the parent application, and they were never "presented/argued/stated" (see MPEP at page 1400-9) during prosecution to make the claims allowable over a prior art rejection. The MPEP at page 1400-10 states:

"Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation rather than a general statement regarding the claims as a whole. In other words, a general "boiler plate" sentence will not be sufficient to establish recapture. An example of one such "boiler plate" sentence is: In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable. This type of general "argument" will not, by itself, be sufficient to establish surrender and recapture. "

In the present case, the Applicants made no amendment to change the claim scope and made no argument at all (because the claims were already deemed allowable), much less a specific argument as required by the MPEP. The Examiner's statement

regarding allowable subject matter in the Office Action of August 17, 1992 is not a specific statement identifying particular limitations which made the claims allowable, but is like the above-noted "boiler plate" statement. That is, it merely identified the claimed subject matter as a whole (i.e., it in essence summarized all of the claim elements). In other words, all that the statement of allowable subject matter said was the prior art does not disclose or suggest the entire combination of the elements of the allowable claims; it did not say that, without any specific one of the claims elements, the claims would not be allowable. In effect, it merely said claims as narrow as claims 2 and 6 were allowable and claims as broad as claims 1 and 6 were not allowable, but there was no discussion of anything intermediate or different from the allowable claims. Thus, the statement of allowable subject matter lacks the requisite specificity required by the MPEP to establish a recapture bar as to any particular element of the allowed claims.

From the above, it is clear that the prosecution history establishes only that it is the combination of the elements of canceled original claim 1 and of original claim 6 that was surrendered, and there was no admission that only claims as narrow as the claims rewritten in independent form are allowable.

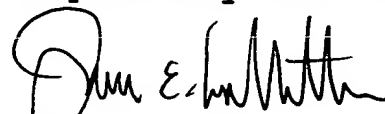
Claims materially different in scope from canceled claims 1 and 6 are thus not barred by the recapture rule.

It is submitted that the above discussion clearly establishes that the present reissue claims do not attempt to recapture what was surrendered earlier and that they differ materially from the surrendered subject matter of canceled claims 1 and 6 of the original application. Accordingly, the presently pending reissue claims do not violate the recapture rule. Withdrawal of this rejection is respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is respectfully solicited.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,



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Exhibit I

33. An optical recording/reproducing system as in claim [28]  
34, wherein each of said first layers comprises a transparent  
substrate.